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Victor Chu

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EXAMINER

WORRELL JR, LARRY D

ART UNIT

PAPER NUMBER

3765

MAIL DATE

DELIVERY MODE

12/15/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/902,834 | CHU, VICTOR | |
| | Examiner | Art Unit | |
| | Danny Worrell | 3765 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-15, 18, 19, 22-42, 44-60 and 62-90 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18, 19, 22-42, 44-60 and 62-90 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-15, 18, 19 and 22-46 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the recitation "wherein the electronic display is not associated with the inherent function of the product" is inaccurate since information concerning a product is "associated" with the function of the product to the extent claimed. Also the recitation "wherein the information is about the product" is indefinite since the specific product is not even being claimed as part of the invention.

In claim 9, the recitation "wherein the electronic display is not associated with the inherent function of the product" is inaccurate and indefinite since in the body of the claim applicant sets forth the step of "attaching an electronic display to the product" and thus such display is in fact part of the product. Furthermore the information about the product is clearly "associated" with the inherent function of the product.

In claim 29, the recitation "information comprising label information, product information or source information" is indefinite since the specific product is not even being claimed as part of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5-8, 29, 30 and 33-36 insofar as definite are rejected under 35 U.S.C. 103(a) as being unpatentable over Gomersall et al (US 4,500,880) in view of Schwendeman et al. (US 4,951,039).

The disclosure of Gomersall et al. (4500880) teaches the invention as claimed including a label (14) for a product comprising: a) a base (14H) adapted to be fixed to said product, b) an LCD (32) electronic display panel affixed to said base and not associated with the inherent functioning of the product; and c) a programmable circuit (note figure 12) operatively connected to said display panel, said programmable circuit being programmed to output label information to said display panel for display thereon. Gomersall et al does not teach that the display is animated. The disclosure of Schwendeman et al. (US 4,951,039) teaches an LCD display device which includes animation as set forth by Schwendeman et al. (US 4,951,039) in column 6, paragraph 3. It would have been obvious at the time the invention was made to provide the LCD display unit of Gomersall et al with animation as shown by Schwendeman et al. (US 4,951,039) in order to convey information in an aesthetically pleasing and/or more effective manner. The preamble recitation of intended use, i.e. "for a product" is considered non-

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controlling as to the metes and bounds of the claim since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Exparte Masham*, 2 USPQ2d 1647 (1987). In this case the label of Gomersall et al. (4500880) clearly has the capability of being adapted to be fixed to a product and whether it actually is, or might be, used in such a manner depends upon the performance of a future act of use rather than a structural distinction in the claims. Concerning the recitation of specific screen images and/or information, it would have been obvious choose from any number of different images including logo information, product information, etc in order to convey specific information to a person depending on the end use of the product and results desired. Clearly one of ordinary skill in the art would possess the common sense to change the display to set forth the information desired for a specific end use.

Claims 1-13, 16, 18, 19, 26, 29-35, 38-42, 44-55, 58-60 and 62-90 are insofar as definite are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitch (US 5,912,653) in view of Schwendeman et al. (US 4,951,039).

Fitch (5912653) teaches the invention as claimed including an apparatus having a label (as seen in figure 3) for a product comprising: a) a base (16) adapted to be fixed to said product, b) an LCD (12) electronic display panel affixed to said base and not associated with the inherent functioning of the product; and c) a programmable circuit (see figure 6) operatively connected to said display panel, said programmable circuit being programmed to output information to said display panel for display thereon. Fitch (5912653) also teaches insofar as definite the method for

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labeling a product of claims 9-15 including attaching an electronic display to the product, and programming the electronic display to display information. Note the electronic display is a liquid crystal display with a backlight. Fitch does not set forth that the LCD is animated. The disclosure of Schwendeman et al. (US 4,951,039) teaches an LCD display device which includes animation as set forth by Schwendeman et al. (US 4,951,039) in column 6, paragraph 3. It would have been obvious at the time the invention was made to provide the LCD display unit of Gomersall et al with animation as shown by Schwendeman et al. (US 4,951,039) in order to convey information in an aesthetically pleasing and/or more effective manner. Concerning the recitation of specific screen images and information displayed thereon, it would have been obvious choose from any number of different images and information including logo information, product information, etc in order to convey specific information to a person depending on the end use of the product and results desired. Clearly one of ordinary skill in the art would possess the common sense to change the display to set forth the information desired for a specific end use.

Claims 14, 15, 27, 28, 36, 37, 26 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitch (US 5,912,653) in view of Schwendeman et al. (US 4,951,039).

The combination of Fitch (US 5,912,653) in view of Schwendeman et al. (US 4,951,039) teaches the invention substantially as claimed. They do not teach the specific LCD with pressure activated switches and a touchscreen. The examiner takes Official notice that pressure

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activated switches and touch screens are typically used in LCDs. It would have been obvious at the time the invention was made to one of ordinary skill in the art to which the invention pertains to provide the LCD of Fitch (5912653) with a pressure activated switch and a touch screen in order to control the display functions of the LCD.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

Applicant's arguments filed 6/4/09 have been fully considered but they are not persuasive.

It remains the examiner's opinion that the recitation "wherein the electronic display is not associated with the inherent function of the product" is indefinite. Applicant's disclosure as to what is or is not considered an "inherent function" of a product is left open to broad

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interpretation and dependent on what one may or may not be considered a product's function.

One of the inherent functions of a shirt may be to cover the upper torso of a wearer but additional inherent functions may include providing aesthetic appeal or disseminating information to the wearer or others for marketing purposes, instruction or the like. As such once information is set forth on a product the "inherent function" of that product includes disseminating information.

Bridging pages 3 and 4 of the disclosure, applicant provides examples for information provided on the claimed electronic label stating:

"for purposes of this application, the term "label information" means a brand name, logo, or slogan which identifies the source or origin of the product; product information, or source information. "Product information" means information about the features, use, or care of the product to which the label 10 is attached. "Source information" means information concerning the manufacturer, seller, or source of the product, such as an address (including an e-mail address) or telephone number for contacting the company, or an address of a web page for finding additional information about the company and its products.

Clearly an electronic display having the above information placed on a product is in fact associated with the inherent function of the product as reasonably interpreted. Therefor to claim "wherein the electronic display is not associated with the inherent function of the product" is inaccurate and indefinite.

Concerning applicant's argument that Gomersall et al is not "adapted to be affixed" to said product. The examiner disagrees and notes that Gomersall et al shows a base capable of being fixed to a product and therefore it meets the claimed limitation of "adapted to be fixed". Concerning applicant's argument of the specific information displayed on the label. It remains the examiner's opinion that it would have been obvious to choose from any number of different images including logo information, product information, etc in order to convey specific information to a person depending on the end use of the product and results desired. The

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resultant display merely yields predictable results, namely an electronic display which shows familiar product information to the user. Clearly one of ordinary skill in the art would possess the common sense to change the display to set forth the information desired for a specific end use.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danny Worrell whose telephone number is 571/272-4997. The examiner can normally be reached on MONDAY-THURSDAY.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, GARY WELCH can be reached on 571/272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Danny Worrell/
Primary Examiner, Art Unit 3765